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of the network of paths and the second deck of cards being collectible cards that are collected and exchanged by the players during the course of the game; and wherein the second deck of cards are "Band Member" cards and include a plurality of groups of cards with each group of cards representing a band and the members of the band, and wherein the object of the game is to arrive at the performing stage with a certain number of cards representing a band and its members.

A2
13. (amended) The game board and game of claim 11 further including a third deck of the "Band Equipment" cards and wherein a further object of the game is to arrive at the performing stage with a "Band Equipment" card.

REMARKS

The comments of the examiner, as set forth in the official Office Action have been carefully studied and reviewed. In this response, Claims 11 and 13 have been amended, and Claim 12 has been cancelled without prejudice. For the reasons set forth below, it is respectfully urged that all pending claims are now in condition for allowance, and an allowance is respectfully requested.

First, the Examiner has rejected Claims 1-14 under 35 U.S.C. §112 as failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner suggests that there is some confusion as to whether an apparatus is being claimed or a method is being claimed. All of the claims are intended to be apparatus claims. The recitation of "a game board and game" is meant to claim the game board and the components of the game, as well as how the game is played with the game board and the various components. It is respectfully urged that the recitation of "a game board and game" is not indefinite in any way, especially in view of Applicant's representations that the claims are not method claims.

First, Claims 11-14 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ferguson. As noted above, Claim 11 has been amended. Particularly, the subject matter of Claim 12 has been incorporated into Claim 11. Claim 12 particularly recites that the second deck of cards are "band member" cards, and include a plurality of groups of cards with each group of cards representing a band and the members of the band, and wherein the object of the game is to arrive at the performing stage with a certain number of cards representing a band and its members. The Ferguson Patent does not anticipate nor render obvious Claim 11, as amended. In order to anticipate, the applied reference must show each and every element and limitation of the claim. That is, every element and limitation of the claim must be identically shown in a single reference. In re Bond, 910 F.2d 831, 15 U.S.P.Q. 2d 1566 (Fed. Cer. 1990).

Claim 11, as now amended, simply does not recite first and second decks of cards. Claim 11, as now amended, particularly recites that the second deck of cards are "band member" cards. In order to anticipate this claim, the reference must teach "band member" cards. The Ferguson reference simply does not do that, and for that matter, no art cited teaches band member cards. For that reason, Claim 11, as now amended, and all claims depending therefrom directly or indirectly are allowable over the Ferguson reference.

Next, the Patent Office rejects Claims 1-10 and 15 as being unpatentable under 35 U.S.C. §103(a) over three patents, the patents to Gorski, in view of the patent to Ferguson, and in further view of the patent to Delessio. For the reasons articulated below, the Examiner has not made out a prima facie case of obviousness.

It is basic and fundamental that in order for there to be a prima facie case of obviousness, the combined patents must show each and every element and limitation set forth in the claims, and further there must be a motivation for combining the references. In this case, the prima facie of obviousness fails on both counts.

That is, even if there was a proper motivation established for combining the three patents together, the three patents together still do not teach nor suggest the claimed subject

matter of Claim 1. In particular, neither Gorski, Ferguson nor Delessio show a game board and game that includes band member cards or band equipment cards, as those terms are used in the claims and defined in the specification. Again, the fact that one or more cited patents may show a game board that includes several groups of cards is not sufficient to form a basis for rejecting any of the claims in this application. The claims go beyond simply claiming a deck or set of cards. They are particular cards. They are band member cards and band equipment cards. Further, Claim 1, for example, is limited to a game where the object of the game is for each player to advance a token along the network of paths and reach the central stage with a predetermined number of one group of band member cards and a band equipment card. Again, that subject matter recited in Claim 1 is not met by the three references, alone or in combination.

Therefore, it is respectfully urged that a prima facie of obviousness is not made out here, because the combined teachings of the three applied references do not even teach nor suggest the limitations of the claims.

Secondly, no prima facie case of obviousness is made out because there is indeed no motivation to combine the three references. First, all three patents relate to games and game boards that have different game boards, different components, different objects and different game themes. The Examiner notes that Gorski teaches all limitations, except that it does not teach play money and path branching one from another. Applicant respectfully disagrees. As noted above, there are numerous limitations in Claim 1, for example, that Gorski does not teach. Again, Gorski does not teach the band member cards, nor the band equipment cards, nor the provisions provided for in the last paragraph of Claim 1. Notwithstanding, the Examiner goes on to say that Ferguson teaches multiple path branching from each other. Then the Examiner concludes that in order to make the game interesting, it would have been obvious to change the path on the board. There is nothing in the cited references that would indicate that providing multi-paths along the game board in and of itself creates additional or desirable interest.

Indeed, there is no suggestion in any of the art that multi-path game boards are anymore interesting than a single path game board.

Next, the Examiner indicates that the first two references, the references to Gorski and Ferguson, do not show fake money. The Examiner combines Delessio and recites that a person of ordinary skill of the art would make the combination because such would make the game more interesting. There is no evidence that utilizing fake money in the Gorski game would make the game more interesting. Indeed, there is not even a suggestion that utilizing fake money would even fit into the theme or the objects of the Gorski game. In short, there is no motivation to combine either Ferguson or Delessio with Gorski. The motivation or the inclination to do so comes only from Applicant's claimed invention and is, in reality, based on hindsight.

For the reasons set forth above, it is respectfully urged that the present application is a condition for allowance and allowance is respectfully requested.

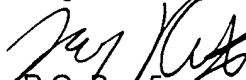
Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

Respectfully submitted,

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5/10/02

"Version with markings to show changes made."

11. (amended) A game board and game comprising: a game board having a performing stage and a network of paths including a plurality of paths that lead to the [performance] performing stage; a series of tokens for being advanced from a starting point along paths along the network of paths with the object being to advance the tokens to the performing stage; and at least two decks of cards, a first deck of cards and a second deck of cards, and wherein the first deck of cards include "Consequence" cards that are key to increments designated along the respective paths of the network of paths and the second deck of cards being collectible cards that are collected and exchanged by the players during the course of the game; and wherein the second deck of cards are "Band Member" cards and include a plurality of groups of cards with each group of cards representing a band and the members of the band, and wherein the object of the game is to arrive at the performing stage with a certain number of cards representing a band and its members. [and wherein the object of the game is to reach the performing stage by advancing a token and with a certain number of cards of the second deck.;

13. (amended) The game board and game of claim [12] 11 further including a third deck of the "Band Equipment" cards and wherein a further object of the game is to arrive at the performing stage with a "Band Equipment" card.